

Applicants would like to thank the Examiner's Supervisor, Supervisory Primary Examiner Padmanabhan, for making time to speak with the Applicants' counsel via telephone on July 7, 2004.

Claims 1-112 are pending and stand rejected in this application.

No amendments have been made at this time, and thus no new matter has been added.

## **II. Provisional Obviousness-Type Double Patenting Rejection**

The Examiner has provisionally rejected claims 1-14 and 41-104 under the judicially created doctrine of double-patenting as being unpatentable over claims 1-83 of co-pending Application No. 09/692,360; claims 1-95 of co-pending Application No. 09/692,155; and claims 1-16, 37-104 of co-pending Application No. 09/692,716.

Applicants respectfully remind the Examiner that she had agreed, during the interview on August 26, 2003, to hold the provisional double-patenting rejection of these claims in abeyance until allowable subject matter has been indicated. Applicants again respectfully request that the Examiner hold the provisional double-patenting rejection in abeyance until allowable subject matter has been indicated. At that time, Applicants will consider whether or not it is appropriate to file a Terminal Disclaimer.

## **III. Rejections Under 35 U.S.C. § 103(a)**

The Examiner has maintained the following rejections under 35 U.S.C. § 103(a):

(A) claims 1-31, 38-67, and 94-112 as being unpatentable over Dalle *et al.* (EP 0874017) ("Dalle") in view of Dubief *et al.* (U.S. Pat. No. 5,650,383) ("Dubief '383") and Restle *et al.* (U.S. Pat. No. 6,039,936) ("Restle") (Final Office Action at 2-5);

(B) claim 32 as being unpatentable over the Dalle/Dubief '383/Restle combination further in view of Grollier *et al.* (U.S. Patent No. 5,063,051) (Grollier '051) (Final Office Action at 5);

(C) claim 33 as being unpatentable over the Dalle/Dubief '383/Restle/Grollier '051 combination further in view of Grollier *et al.* (U.S. Patent No. 4,957,732) ("Grollier '732") (Final Office Action at 5-6);

(D) claims 34-37 as being unpatentable over the Dalle/Dubief '383/Restle/Grollier '051/Grollier '732 combination further in view of Dubief *et al.* (U.S. Patent No. 6,011,126) ("Dubief '126") (Final Office Action at 6-7); and

(E) claims 68-93 as being unpatentable over the Dalle/Dubief '383/Restle/Grollier '051/Grollier '732/ Dubief '126 combination further in view of Inman (U.S. Patent No. 5,948,739) ("Inman") (Final Office Action at 7-8).

Applicants continue to respectfully traverse these rejections for at least the reasons of record and for the additional reasons set forth below. The Examiner has yet to establish a *prima facie* case of obviousness. In particular, the references cited by the Examiner in the current rejections do not teach or suggest all of the claim limitations, nor is there any suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify or combine references, and the Examiner has not shown a reasonable expectation of success in making a combination of the references. See M.P.E.P. § 2143. Thus, the Examiner has failed to meet any, let alone all three criteria required for a *prima facie* showing of obviousness. See, e.g., Amendment under 37 C.F.R. § 1.114 filed March 4, 2004.

In addition, the Examiner has not given the proper consideration to the Experimental Results and Declaration under 37 C.F.R. § 1.132 submitted by Applicants on March 4, 2004. In particular, Applicants respectfully assert that the Examiner has both objectively misread and subjectively under-valued the submission. For example, the Examiner states that “the formulation table does not show how much or what insoluble silicone was actually used.” Final Office Action at 10. Applicants respectfully point out to the Examiner that the row of the table describing the insoluble silicone used “broke” across two pages. However, as discussed with the Examiner’s supervisor, it is still plainly visible that one gram of polydimethylsiloxane (DC200 Fluid-60,000CS from Dow Corning) was used only in Composition A (the invention). Polydimethylsiloxane is an insoluble silicone, and while its label as such appeared on the next page, its nature does not change.

Moreover, the Examiner asks “[w]as the Dubief insoluble silicone used in Composition A?” Final Office Action at 10. Applicants respectfully submit that such a question underscores the Examiner’s own confusion over her asserted rejection. As discussed in Applicants’ responses of record, **Dubief does not teach an additional insoluble silicone**. Hence, Example A (the invention) comprised an insoluble silicone of the invention, while the comparative example representing Dubief, Example B, comprised one gram of a **water soluble silicone**. See Declaration under 37 C.F.R. § 1.132 at 2-3.

Tellingly, the Examiner continues to evidence her apparent misunderstanding of the experimental results when she states “assuming that same ‘insoluble silicone’ were used in both Compositions A and B, the resulting data shows that treatment with the

composition comprising the Dalle silicone emulsion produces better disentangling than the treatment with the other composition which comprises Abilquat 3434.” Final Office Action at 10-11. The insoluble silicone was **not** used in both Composition A and Composition B. Composition A represents the invention, thus the insoluble silicone was only used in Composition A. As discussed above, Composition B does not contain a second insoluble silicone.

Finally, the Examiner admits that Composition A gives better results than Composition B, yet the Examiner “takes the position that the 22% improvement which is assessed by a subjective opinion does not amount to a surprising or unexpected, greater than expected results in view of the strong teachings of the references.” Final Office Action at 11. Applicants respectfully point out that the “strong teachings” of the references are also subjective, as many hair care results are, due to the nature of the intended results. Moreover, 22% improvement can hardly be ignored, or considered insignificant, especially in light of the Examiner’s misunderstanding of both the references and the comparative data that she is relying on to maintain the rejections.

As discussed in previous responses of record, the present invention differs from Dalle in many ways, including that it possesses additional benefits resulting from its additional components. These benefits, for example, those associated with the additional silicone, are not suggested by either Dalle or Dubief ‘383 *in a manner that would have motivated one of ordinary skill in the art to combine the teachings of Dalle and Dubief ‘383*. The experimental results submitted with the Declaration under 37 C.F.R. § 1.132 further emphasize this point.

Applicants again remind the Examiner that the allegedly relevant passage relied on in Dubief '383 actually states ". . . compositions according to the invention may optionally also contain other agents whose effect is to improve the properties of keratinous matter . . . **on condition that they do not impair the stability of the compositions**, such as cationic surface-active agents . . . or else **silicones which are soluble in the mixture**. Dubief '383, col. 7, lines 56-67 (emphasis added). Thus, Dubief '383 teaches only the possible use of additional silicones that are soluble in the mixture, and which do not impair the stability of the compositions, contrary to the presently claimed invention, which recites an additional silicone that is insoluble. See claim 1. In an obviousness determination, the Examiner must consider the reference teachings as a whole, taking into consideration portions that would lead away from the claimed invention. See M.P.E.P. § 2141.02; *see also* M.P.E.P. § 2145(D).

For at least the foregoing reasons, the Examiner has failed to show that the Dalle/Dubief '383/Restle combination contains each of the elements of the claimed invention. In addition, the references do not provide a teaching that would motivate one to combine their teachings, nor do the references provide a reasonable expectation of success in their combination. Moreover, the Examiner's review of the experimental results submitted with the Declaration under 37 C.F.R. § 1.132 was inaccurate and cursory at best.

As the Examiner has failed to satisfy her burden under 35 U.S.C. § 103, with respect to the primary combination of references, *i.e.*, Dalle/Dubief '383/Restle, Applicants respectfully submit that this combination and all other combinations with

secondary references (i.e., Grollier '732, Dubief '126, and Inman) relying on Dalle/Dubief '383/Restle are improper.

Applicants respectfully request that the Examiner reexamine her conclusions regarding the experimental results and the references relied upon in light of the foregoing remarks. Accordingly, Applicants respectfully request withdrawal of all § 103 rejections.

**IV. Conclusion**

In view of the foregoing remarks, Applicants respectfully request the consideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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